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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,170

Applicant(s)

MARUKAWA, KAZUYUKI

Examiner

Doug Hutton

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-99 is/are pending in the application.
- 4a) Of the above claim(s) 41-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 and 84-99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on 15 October 2004 is acknowledged.

Claims 41-83 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 15 October 2004.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan on 18 November 1999. It is noted, however, that applicant has not filed certified copies of the Japanese applications as required by 35 U.S.C. 119(b).

The certified copy of Japanese Patent Application No. P11-328728 has been received. However, the certified copies of Japanese Patent Application Nos. P11-328726 and P11-328726 have not been received.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 1 is objected to because of the following informalities:

- the phrase "of a plurality" should be inserted between the terms "one" and "of" in Line 5 to indicate that there are a plurality of categories.

Claim 3 is objected to because of the following informalities:

- the term "itself" in Line 3 should be deleted so that the claim reads more clearly.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 10, 11, 13, 14, 16-18, 19, 26, 27, 29, 30 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 13, 18, 19, 26, 17 and 39:

Claim 1 recites "an electronic document" five different times (see Lines 4-5, 10, 14, 21-22 and 28). The claim is indefinite because it is unclear whether these "electronic documents" are a single document or multiple documents.

The present invention clearly includes an online search and retrieval service that retrieves documents from a database when said documents meet the user's search criteria (see the "control means" of the server in Lines 25-32). However, it is unclear whether the system allows a user to categorize and upload documents to a storage database.

Applicant must amend the claim to particularly point out and distinctly claim whether the document processing system manipulates only a single document at a time or multiple documents at a time. If the document processing system involves the manipulation of multiple documents, Applicant must amend the claim to particularly point out and distinctly claim the separate, independent functions performed involving the documents.

Claims 2, 3, 13, 18, 19, 26, 17 and 39 have the same problem.

Claims 1, 2, 10, 11, 13, 14, 16, 17, 26, 27, 29 and 30:

Claims 1, 2, 10 and 11 each refer to a “categorization means.” In Claims 1 and 2, the functions of the “categorization means” appears to allow the user to specify a particular category of documents in which to conduct the search.

However, Claim 10 recites that the “categorizing means” “temporarily determines a category in which the electronic document received from said document providing device is to be categorized” (see Lines 2-4) and then determines if the “temporary category” is the same as: 1) the “category specified by said specification information input means” (see Lines 7-8 and Lines 13-15), or 2) the “category to which the specified document belongs” (see Lines 9-10 and Lines 15-16).

This limitation in Claim 10 is indefinite because it does not correspond with Claims 1 and 2. That is, the user will initially specify the category of documents in which to conduct the search and no documents outside of the specified category will be retrieved from the server. Thus, no determination of the category to which the document belongs is necessary at the client computer, because the server will only retrieve documents in the specified category. Any comparison of the document category and the specified category will occur at the server before the documents are retrieved and transmitted to the client computer.

Claim 11 also recites that the “categorizing means” “categories the electronic document received from said document providing device into a category” (see Lines 2-

4). This limitation in Claim 11 is indefinite because it does not correspond with Claims 1 and 2 for the same reasons specified in the above discussion regarding Claim 10.

Claims 13, 14, 16 and 17 and Claims 26, 27, 29 and 30 have the same problem.

Applicant must amend the claims to particularly point out and distinctly claim the functions of the "categorizing means" and where these functions are performed.

For purposes of examination, the examiner will assume that the "categorizing functions" of Claims 10 and 11 occur at the server.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-22, 24-35, 37-40 and 84-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson et al., U.S. Patent No. 5,819,092.

Claim 1:

Ferguson discloses a document processing system comprising a terminal device and a document providing device (see Figure 1; see Column 8, Lines 4-28 – Ferguson

discloses this limitation in that the online development tool is used to create online computer services that involve clients and servers),

- said terminal device comprising:
 - categorizing means for categorizing an electronic document into one of categories according to a characteristic of said electronic document (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22 – Ferguson discloses this limitation in that the online services created by the development tool provide searchable directories of hyperdocuments arranged in categories and allows client users to search the directory by categories; also, Ferguson discloses this limitation in that the online services include a “document harvester” that allows a user to index documents uploaded to or downloaded from the system; thus, the online services “categorize an electronic document into one of categories according to a characteristic of said electronic document”);
 - communication means for communicating with said document providing device (see Figure 1 – Ferguson discloses this limitation in that the online services connect the clients and servers via a communications network);
 - specification information input means for specifying an electronic document categorized in one of said categories or specifying one of said categories (see Column 13, Line 65 through Column 14, Line 12 – Ferguson discloses this limitation in that the online services allow client

users to search the documents in storage directories by names, categories or keywords); and

- control means for controlling said communication means so as to transmit, to said document providing device, an electronic document specified by said specification information input means or characteristic information indicating the characteristic of a category specified by said specification information input means (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services transmit a client user's search requests to the servers via the communications network; also, Ferguson discloses this limitation in that the online services include a "document harvester" that allows a user to index documents uploaded to or downloaded from the system; also, Ferguson discloses this limitation in that the online services provide a means for paying a content provider for documents that are uploaded to the system via the communications network and then accessed by users on the system; in order to properly categorize such documents, the content providers will use Directory Lookup services to categorize and provide "specific information" for the uploaded documents);
- said document providing device comprising:
 - a database for storing a plurality of electronic documents (see Column 13, Line 65 through Column 14, Line 12 – Ferguson discloses this limitation in

that the online services provide searchable directories of information comprising hyperdocuments; thus, Ferguson discloses a “database for storing a plurality of electronic documents”);

- retrieval means for retrieving a desired electronic document from the electronic documents stored in said database (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories);
- communication means for communicating with said terminal device (see Figure 1 – Ferguson discloses this limitation in that the online services connect the clients and servers via a communications network); and
- control means for controlling said communication means and said retrieval means such that when said communication means receives said characteristic information, said retrieval means retrieves an electronic document related to said characteristic information from the electronic documents stored in said database, and said communication means transmits information associated with the retrieved electronic document to said terminal device (see Figure 1; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client

users to retrieve hyperdocuments from the directory and receive the retrieved hyperdocuments at their computers).

Claim 2:

Ferguson discloses the document processing system of Claim 1, wherein said control means of said terminal device transmits an electronic document specified by said specification information input means or characteristic information indicating the characteristic of a category specified by said specification information input means together with an identifier of the specified electronic document or category to said document providing device via said communication means (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22 – Ferguson discloses this limitation in that the online services provide a “directory lookup subservice” that allows the user to specify a particular category of documents in which to conduct the search; also, Ferguson discloses this limitation in that the online services include a “document harvester” that allows the user to index documents uploaded to or downloaded from the system).

Claim 3:

Ferguson discloses the document processing system of Claim 1, wherein said control means of said document providing device transmits an electronic document itself extracted by retrieval, as said information associated with the retrieved electronic document, to said terminal device via said communication means (see Figure 1; see

Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23;—

Ferguson discloses the above limitation in that the online services development tool is used to design and construct online computer services that include searching, downloading and viewing online information. The tool is used to create the data structures, documents, scripts and HTTP software to implement the online services. Features provided by such online services include: displaying hypermedia and portable documents, full-text indexing, full-text searching, full-text retrieving, attribute-based searching, downloading data or programs and controlling access to online information.

In the areas of indexing, searching and retrieving online documents, the online services comprise a “directory lookup subservice,” a “document retrieval subservice,” an “electronic publishing subservice” and a “document harvester.” Each of these subservices are further described in the following discussion.

The “directory lookup subservice” provides a searchable directory of information that includes hyperdocuments that can be arranged into categories. The hyperdocuments in this directory are searchable by name, by category or by keywords.

The “document retrieval subservice” allows users to retrieve documents using full-text search techniques with user-specified categories and keywords. This subservice provides searchable access to a large corpus of text and makes files on a file server available to geographically remote users.

The "electronic publishing subservice" provides users with an electronic edition of a newspaper or magazine that the user can download to the client computer. This subservice creates a customized daily newspaper that provides only news stories that match certain criteria provided previously by the user.

Each of the above elements are expressly disclosed in Ferguson. However, a reference's disclosure may also be implied. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998).

Ferguson would have reasonably suggested to one having ordinary skill the art the following:

Using the online services development tool, a developer could have created a search tool that retrieved electronic documents from a server based on search criteria submitted by a client user and presented a list of every retrieved document to the user at the client. Upon receipt of the list, the user would have selected the documents that he/she desired to view. Upon selection, the server delivered the selected document to the client computer.

Ferguson would have reasonably suggested the aforementioned disclosure because that is how typical search and retrieval systems worked at the time the invention was made.

Thus, the online services in Ferguson disclose a “control means” of said document providing device that “transmits an electronic document itself extracted by retrieval.”).

Claim 4:

Ferguson discloses the document processing system of Claim 1, wherein said control means of said document providing device transmits a list of electronic documents extracted by retrieval, as said information associated with the retrieved electronic document, to said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server presenting a list of every retrieved document to the user at the client ; thus, the online services in Ferguson disclose a “control means” of said document providing device that “transmits a list of electronic documents extracted by retrieval”).

Claim 5:

Ferguson discloses the document processing system of Claim 4, wherein said terminal device further comprises electronic document specifying means for, when said

list is received via said communication means, inputting electronic document specifying information to specify a particular electronic document of those included in said list, and said control means of said terminal device transmits the electronic document specifying information input via said electronic document specifying means to said document providing device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the user selecting the documents that he/she desired to view; thus, the online services in Ferguson disclose a client computer that further comprises “electronic document specifying means” for “inputting electronic document specifying information to specify a particular electronic document of those included in said list” and transmitting said user specification to the server).

Claim 6:

Ferguson discloses the document processing system of Claim 5, wherein said control means of said document providing device transmits an electronic document specified by electronic document specifying information received from said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line

63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server transmitting selected documents to the user at the client; thus, the online services in Ferguson disclose a “control means” of the server that “transmits an electronic document specified by electronic document specifying information received from said terminal device via said communication means”).

Claim 7:

Ferguson discloses the document processing system of Claim 4, wherein said control means of said document providing device produces said list such that electronic documents retrieved by said retrieval means from said database are all included in said list, and said control means transmits said list to said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server putting together a list that includes every retrieved document and transmitting the list to the user at the client; thus, the online services in Ferguson disclose a “control means” of the server that “produced said list such that electronic

documents retrieved by said retrieval means from said database are all included in said list”).

Claim 9:

Ferguson discloses the document processing system of Claim 4, wherein said control means of said document providing device produces said list such that a full or partial set of electronic documents retrieved by said retrieval means from said database is sorted and the resultant sorted set of electronic documents is included in said list, and said control means transmits said list to said terminal device via said communication means (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server putting together a list that includes every retrieved document and transmitting the list to the user at the client; also, the list is *inherently* “sorted” in that any list of retrieved documents will be in some sort of order; thus, the online services in Ferguson disclose a “control means” of the server that “produced said list such that a full or partial set of electronic documents retrieved by said retrieval means from said database is sorted and the resultant sorted set of electronic documents is included in said list”).

Claim 10:

Ferguson discloses the document processing system of Claim 2, wherein said categorizing means temporarily determines a category in which the electronic document received from said document providing device is to be categorized, in accordance with the characteristic of said electronic document, if said category determined is the same as the category specified by said specification information input means or as the category to which the specified electronic document belongs, said categorizing means categorizes said electronic document received from said document providing device into said category, and if said category determined is different from the category specified by said specification information input means or from the category to which the specified electronic document belongs, said categorizing means categorizes said electronic document received from said document providing device into a category in accordance with an instruction given by a user (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server comparing whether the searched documents meet the categorization criteria specified by the user; that is, if the category is the same, then the document is transmitted to the client computer provided the document meets all other search criteria specified by the user, and, if the category is different, then the

document fails to meet the search criteria specified by the user and is not transmitted to the client computer).

Claim 11:

Ferguson discloses the document processing system of Claim 1, wherein when said categorizing means categories the electronic document received from said document providing device into a category, said categorizing means updates the category information (see Column 18, Lines 13-22 – Ferguson discloses this limitation in that the online services include a “document harvester” that allows a user to index documents uploaded to or downloaded from the system; thus, the “categorizing means categories the electronic document received from said document providing device into a category” and “updates the category information”).

Claim 12:

Ferguson discloses the document processing system of Claim 1, wherein said document providing device further comprises accounting means for, when said document providing device transmits the electronic document to said terminal device, performing an accounting process associated with the fee to said terminal device (see Column 25, Lines 41-46; see Column 29, Line 35 through Column 31, Line 58 – Ferguson discloses this limitation in that the online development tool includes a “fee setter subtool” that allows a developer to specify the fees that will be levied on users

that download documents from the servers or paid to content providers that provide content to the servers).

Claims 13-17:

Claims 13-17 merely recite the “terminal device” of Claims 1, 2, 5, 10 and 11, respectively. Thus, Ferguson discloses every element of these claims using the same rationale set forth in the above rejections.

Claims 18-20, 22, 24 and 25:

Claims 18-20, 22, 24 and 25 merely recite the “document providing device” of Claims 1, 3, 4, 7, 9 and 12, respectively. Thus, Ferguson discloses every element of these claims using the same rationale set forth in the above rejections.

Claim 21:

Claim 21 merely recites limitations of the “document providing device” of Claims 5 and 6. Thus, Ferguson discloses every element of this claim using the same rationale set forth in the above rejections.

Claim 26:

Ferguson discloses a document processing method (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is

used to create online computer services that involve clients and servers), comprising the steps of:

- categorizing electronic documents into a plurality of categories in accordance with the characteristic of the respective electronic documents (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22 – Ferguson discloses this limitation in that the online services created by the development tool provide searchable directories of hyperdocuments arranged in categories and allows client users to search the directory by categories; also, Ferguson discloses this limitation in that the online services include a “document harvester” that allows a user to index documents uploaded to or downloaded from the system; thus, the online services “categorize electronic documents into a plurality of categories in accordance with the characteristic of the respective electronic documents”);
- requesting specifying an electronic document categorized in one of said categories or specifying of one of said categories (see Column 13, Line 65 through Column 14, Line 12 – Ferguson discloses this limitation in that the online services allow client users to search the documents in storage directories by names, categories or keywords); and
- transmitting, to a document providing device, an electronic document or characteristic information indicating the characteristic of a category, specified in response to said request in said requesting step (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22; see Column 31, Lines

32-42 – Ferguson discloses this limitation in that the online services transmit a client user's search requests to the servers via the communications network).

Claim 27:

Ferguson discloses the document processing method of Claim 26, wherein in said transmission step, a specified electronic document or characteristic information indicating the characteristic of a specified category is transmitted together with an identifier of the specified electronic document or category to said document providing device (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22 – Ferguson discloses this limitation in that the online services provide a “directory lookup subservice” that allows the user to specify a particular category of documents in which to conduct the search).

Claim 28:

Ferguson discloses the document processing method of Claim 26, further comprising the steps of:

- requesting, when a list of electronic documents retrieved in accordance with said characteristic information is received from said document providing device, inputting of electronic document specifying information which specifies a particular electronic document of those included in said list; and
- transmitting, to said document providing device, the electronic document specifying information input in response to said request (see Figure 1; see

Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the user selecting the documents that he/she desired to view; thus, the online services in Ferguson disclose a client computer that further comprises “inputting electronic document specifying information to specify a particular electronic document of those included in said list” and transmitting said user specification to the server).

Claim 29:

Ferguson discloses the document processing method of Claim 26, wherein in said categorizing step, a category, in which the electronic document received from said document providing device is to be categorized, is temporarily determined in accordance with the characteristic of said electronic document, if said temporarily-determined category is the same as the category specified in response to said specifying request or as the category to which the specified electronic document belongs, said electronic document received from said document providing device is categorized into said category, and if said temporarily-determined category is different from the category specified in response to said specifying request or from the category to which the specified electronic document belongs, said electronic document received

from said document providing device is categorized into a category in accordance with an instruction given by a user (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server comparing whether the searched documents meet the categorization criteria specified by the user; that is, if the category is the same, then the document is transmitted to the client computer provided the document meets all other search criteria specified by the user, and, if the category is different, then the document fails to meet the search criteria specified by the user and is not transmitted to the client computer).

Claim 30:

Ferguson discloses the document processing method of Claim 29, wherein in said categorizing step, when the electronic document received from said document providing device is categorized into a category, category information is updated (see Column 18, Lines 13-22 – Ferguson discloses this limitation in that the online services include a “document harvester” that allows a user to index documents uploaded to or downloaded from the system; thus, the “categorizing means categories the electronic document received from said document providing device into a category” and “updates the category information”).

Claim 31:

Ferguson discloses a document processing method (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is used to create online computer services that involve clients and servers), comprising the steps of:

- when characteristic information of an electronic document or a category is received, retrieving an electronic document related to said characteristic information from a plurality of electronic documents stored in a database (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories by transmitting a client user's search requests to the servers via the communications network); and
- transmitting information associated with the electronic document retrieved in said retrieving step (see Figure 1; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to retrieve hyperdocuments from the directory and receive the retrieved hyperdocuments at their computers).

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Claim 32:

Ferguson discloses the document processing method of Claim 31, wherein in said transmission step, the electronic document itself extracted by retrieval is transmitted, as said information associated with the retrieved electronic document, to said terminal device (as indicated in the above rejection for Claim 3, Ferguson discloses "transmitting the retrieved electronic documents and information associated with the documents to the terminal device").

Claim 33:

Ferguson discloses the document processing method of Claim 31, wherein in said transmission step, a list of electronic documents extracted by retrieval is transmitted, as said information associated with the retrieved electronic document, to said terminal device (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server presenting a list of every retrieved document to the user at the client ; thus, the online services in Ferguson disclose a "control means" of said document providing device that "transmits a list of electronic documents extracted by retrieval").

Claim 34:

Ferguson discloses the document processing method of Claim 33, wherein in said transmission step, when electronic document specifying information which specifies a particular electronic document of the electronic documents included in said list is received from said terminal device, the electronic document specified by said electronic document specifying information is transmitted to said terminal device (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the user selecting the documents that he/she desired to view; thus, the online services in Ferguson disclose a client computer that further comprises “electronic document specifying means” for “inputting electronic document specifying information to specify a particular electronic document of those included in said list” and transmitting said user specification to the server).

Claim 35:

Ferguson discloses the document processing method of Claim 33, wherein in said transmission step, said list is produced such that electronic documents retrieved from said database in said retrieving step are all included in said list, and said list is transmitted to said terminal device (see Figure 1; see Column 6, Line 65 through

Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server putting together a list that includes every retrieved document and transmitting the list to the user at the client; thus, the online services in Ferguson disclose a “control means” of the server that “produced said list such that electronic documents retrieved by said retrieval means from said database are all included in said list”).

Claim 37:

Ferguson discloses the document processing method of Claim 33, wherein in said transmission step, said list is produced such that a full or partial set of electronic documents retrieved from said database in said retrieving step is sorted and the resultant sorted set of electronic documents is included in said list, and said list is transmitted to said terminal device (see Figure 1; see Column 6, Line 65 through Column 7, Line 35; see Column 8, Lines 4-35; see Column 10, Line 25 through Column 12, Line 55; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 15, Lines 12-23 – as discussed in the above rejection for Claim 3, Ferguson discloses the features of a typical search and retrieval system, which include the server putting together a list that includes every retrieved document and transmitting the list to the user at the client; also, the list is

inherently “sorted” in that any list of retrieved documents will be in some sort of order; thus, the online services in Ferguson disclose “producing the list such that a full or partial set of electronic documents retrieved from said database in said retrieving step is sorted and the resultant sorted set of electronic documents is included in said list”).

Claim 38:

Ferguson discloses the document processing method of Claim 31, further comprising an accounting step for, when the electronic document is transmitted to said terminal device, performing an accounting process associated with the fee to said terminal device (see Column 25, Lines 41-46; see Column 29, Line 35 through Column 31, Line 58 – Ferguson discloses this limitation in that the online development tool includes a “fee setter subtool” that allows a developer to specify the fees that will be levied on users that download documents from the servers or paid to content providers that provide content to the servers).

Claims 39 and 40:

Claims 39 and 40 merely recite computer software that performs the methods of Claims 26 and 31, respectively. Thus, Ferguson discloses every element of these claims using the same rationale set forth in the above rejections.

Claim 84:

Ferguson discloses a document processing method (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is used to create online computer services that involve clients and servers), comprising the steps of:

- setting specification information to specify an electronic document (see Column 13, Line 65 through Column 14, Line 12 – Ferguson discloses this limitation in that the online services allow client users to search the documents in storage directories by names, categories or keywords);
- transmitting, to a service providing device, specification information set in said specification information setting step and request information indicating a request for a tagged electronic document including a tag indicating the structure of the electronic document specified by said request information (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 18, Lines 13-22; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services transmit a client user's search requests to the servers via the communications network, wherein the client user's search requests may specify both categories and keywords of the sought documents; also, Ferguson discloses this limitation in that the online services allows a user to search hyperdocuments, which include HTML documents having "tags" that "indicate the structure of the electronic document specified by the request information");

- receiving the tagged electronic document which is transmitted from said service providing device in response to said request information and said specification information (see Figure 1; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to retrieve hyperdocuments from the directories and receive the retrieved hyperdocuments at their computers).

Claim 85:

Ferguson discloses the method of Claim 84, wherein in said specification information setting step, said specification information is set using an identifier of an electronic document (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow the user to retrieve text files, which may be retrieved by specifying the name of the text file).

Claim 86:

Ferguson discloses the method of Claim 84, wherein in said specification information setting step, said specification information is set using a keyword included in an electronic document (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow the user to retrieve hyperdocuments via keywords).

Claim 87:

Ferguson discloses the method of Claim 84, wherein in said transmission step, an electronic document is transmitted together with said request information to said service providing device (see Column 13, Line 65 through Column 14, Line 12; see Column 18, Lines 13-22; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services transmit a client user's search requests to the servers via the communications network; also, Ferguson discloses this limitation in that the online services include a "document harvester" that allows a user to index documents uploaded to or downloaded from the system; also, Ferguson discloses this limitation in that the online services provide a means for paying a content provider for documents that are uploaded to the system via the communications network and then accessed by users on the system; in order to properly categorize such documents, the content providers will use Directory Lookup services to categorize and provide "request information" for the uploaded documents).

Claim 88:

Ferguson discloses the method of Claim 87, wherein in said specification information setting step, said specification information is set using an identifier indicating an electronic document to be transmitted to said service providing device (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11; see Column 18, Lines 13-22; see Column 31, Lines 32-42 – Ferguson discloses this limitation in that the online services allow the user to upload

hyperdocuments to the system; in doing this, the user must *inherently* “specify the identify” of the document being uploaded in that no document will be uploaded unless it is “identified” to the system).

Claim 89:

Ferguson discloses a document processing method (see Figure 1; see Column 8, Lines 4-28 – Ferguson discloses this limitation in that the online development tool is used to create online computer services that involve clients and servers), comprising the steps of:

- receiving, from a terminal device, specification information specifying an electronic document and request information indicating a request for a tagged electronic document including a tag indicating the structure of the electronic document specified by said request information (see Figure 1; see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow the directories to receive search requests sent by client users to retrieve hyperdocuments from the directory and receive the retrieved hyperdocuments at their computers; also, Ferguson discloses this limitation in that the online services allows a user to search directories of hyperdocuments that include HTML documents having “tags” that “indicate the structure of the electronic document specified by the request information”);

- determining whether a database includes said tagged electronic document of the electronic document specified by said specification information received in said receiving step (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories); and
- when it is determined in said determining step that said database includes said tagged electronic document of the electronic document specified by said specification information, reading said tagged electronic document from said database and transmitting it to said terminal device (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories).

Claim 90:

Ferguson discloses the method of Claim 89, further comprising the steps of:

- when it is determined in said determining step that said database includes the electronic document specified by said specification information, requesting an authoring device to produce a tagged electronic document of said electronic document (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments

from the directories; the “authoring device” is that part of the system that retrieves the search results from the directories); and

- when said tagged electronic document is received from said authoring unit, transmitting said tagged electronic document to said terminal device (see Column 13, Line 65 through Column 14, Line 12; see Column 14, Line 63 through Column 15, Line 11 – Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories).

Claim 91:

Ferguson discloses the method of Claim 89, further comprising the step of, when it is determined in said determining step that said database includes neither the electronic document specified by said specification information nor the tagged electronic document of said electronic document, transmitting an error notification to said terminal device (Ferguson discloses this limitation in that the online services allow client users to search and retrieve hyperdocuments from the directories; the system “transmits an error notification” if no documents meet the search criteria in that it will indicated to the user that no results were found).

Claim 92:

Ferguson discloses the method of Claim 89, wherein

- said database includes electronic documents or tagged electronic documents together with their associated identifiers (Ferguson discloses this limitation in that the online services includes directories having "electronic documents"),
- in said determining step, it is determined whether said database includes an electronic document or a tagged electronic document in accordance with an identifier received as said specification information (as indicated in the above rejection for Claim 2, Ferguson discloses this limitation).

Claim 93:

Ferguson discloses the method of Claim 89, wherein in said determining step, it is determined whether said database includes an electronic document or a tagged electronic document in accordance with a keyword received as said specification information (as indicated in the above rejection for Claim 86, Ferguson discloses this limitation).

Claim 94:

Ferguson discloses the method of Claim 89, further comprising the steps of:

- when an electronic document is received, in said receiving step, from said terminal device, requesting an authoring device to produce a tagged electronic document of said electronic document (as indicated in the above rejection for Claim 90, Ferguson discloses this limitation); and

- when said tagged electronic document is received from said authoring unit, transmitting said tagged electronic document to said terminal device (as indicated in the above rejection for Claim 90, Ferguson discloses this limitation).

Claim 95:

Ferguson discloses the method of Claim 89, further comprising the step of, when said tagged electronic document is transmitted to said terminal device, performing an accounting process associated with the fee to said terminal device (as indicated in the above rejection for Claim 12, Ferguson discloses this limitation).

Claim 96:

Ferguson discloses the method of Claim 89, further comprising the step of, when said tagged electronic document is transmitted, performing an accounting process associated with the fee to said terminal device (as indicated in the above rejection for Claim 12, Ferguson discloses this limitation) depending upon whether said authoring unit has performed an authoring process associated with said tagged electronic document (if no document is transmitted to the client device, then no fee is assessed).

Claim 97:

Ferguson discloses the method of Claim 89, wherein

- said database includes, together with said electronic documents, authoring permission/prohibition information indicating whether authoring of the respective

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electronic documents is permitted or prohibited (see Column 4, Lines 28-32 – Ferguson discloses this limitation in that the system charges the user a fee to access the online service; if the user has not subscribed to the service, then the user is denied access), and

- in said determining step, said authoring permission/prohibition information is used to determine whether an electronic document is included in said database (see Column 6, Line 65 through Column 7, Line 21 – Ferguson discloses this limitation in that the system controls access to the documents; the user may be granted access to some documents while being denied access to other documents).

Claims 98 and 99:

Claims 98 and 99 merely recite computer software that performs the methods of Claims 84 and 89, respectively. Thus, Ferguson discloses every element of these claims using the same rationale set forth in the above rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson.

Claim 8:

As indicated in the above rejection, Ferguson discloses the document processing system of Claim 4.

Ferguson fails to expressly disclose a control means of said document providing device that produces a list such that electronic documents retrieved by said retrieval means from said database are "partially included" in said list. However, the examiner takes Official Notice that prior art search engines, such as Google and Yahoo, produced lists of search results that displayed a small portion of each retrieved document on the list for the purpose of showing the user the context of the search term as it is used in the document. The examiner remembers using the Yahoo search engine while attending law school in November, 1997 and obtaining search results that included a list of the retrieved documents comprising a small portion of each retrieved document.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Ferguson, to include a control means of said document providing device that produces said list such that electronic documents retrieved by said retrieval means from said database are "partially included" in said list for the purpose of showing the user the context of the search term as it is used in the document.

Claim 23:

Claim 23 merely recites limitations of the “document providing device” of Claim 8. Thus, Ferguson discloses/teaches every element of this claim using the same rationale set forth in the above rejection.

Claim 36:

As indicated in the above rejection, Ferguson discloses the document processing system of Claim 33.

Ferguson fails to expressly disclose producing a list such that electronic documents retrieved from said database are “partially included” in said list. However, the examiner takes Official Notice that prior art search engines, such as Google and Yahoo, produced lists of search results that displayed a small portion of each retrieved document on the list for the purpose of showing the user the context of the search term as it is used in the document. The examiner remembers using the Yahoo search engine while attending law school in November, 1997 and obtaining search results that included a list of the retrieved documents comprising a small portion of each retrieved document.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Ferguson, to include producing the list such that electronic documents retrieved from said database in said retrieving step are “partially included” in said list for the purpose of showing the user the context of the search term as it is used in the document.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kogeneck et al., U.S. Patent No. 5,404,514; Herz et al., U.S. Patent No. 5,754,939; Herz, U.S. Patent No. 6,029,195; Kazino, U.S. Patent No. 4,579,492; Fisher, U.S. Patent No. 3,352,195; and Herz, U.S. Patent No. 6,460,036.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
December 16, 2004

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized, looping flourish at the end.

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**